

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte PAMELA C. GUZMAN, MICHAEL A. WACK,
DALE R. SCHULZE, GARY W. KNIGHT, CHRISTOPHER J. HESS,
RUDOLPH H. NOBIS, MICHAEL F. CLEM, and RONALD J. KOLATA

Appeal 2008-2610
Application 10/154,558
Technology Center 3700

Decided: September 10, 2008

Before DONALD E. ADAMS, ERIC GRIMES, and MELANIE L.
McCOLLUM, *Administrative Patent Judges*.

McCOLLUM, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a bone plating instrument. The Examiner has rejected the claims as anticipated. We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part.

STATEMENT OF THE CASE

Claims 1-3, 5, and 12-14 are on appeal. Claims 4, 6-10, and 15-18 are also pending but have been withdrawn from consideration by the Examiner. (App. Br. 2.) We will focus on claims 1 and 12, which are representative and read as follows:

1. A bone plating instrument, comprising:

a housing,

a shaft having a first end portion thereof secured to the housing such that a second portion thereof extends outwardly away from the housing, the second end portion of the shaft having an access hole,

a screw alignment jig having a first end portion thereof secured to the housing such that a second end portion thereof extends outwardly away from the housing, the second end portion of the screw alignment jig having a guide hole, and

a plate attachment mechanism configured to secure a bone plate to at least one of the shaft and the housing.

12. A bone plating instrument, comprising:

a handle,

a tissue expander secured to the handle, the tissue expander having an access hole, and

a screw alignment jig having a first end portion thereof secured to the handle such that a second end portion thereof extends outwardly away from the handle, the second end portion of the screw alignment jig having a guide hole.

Claims 1-3, 5, and 12-14 stand rejected under 35 U.S.C. § 102(b) as anticipated by Ball (US 3,486,500, Dec. 30, 1969).¹ The Examiner finds that Ball discloses a device having all of the limitations of claims 1 and 12 (Ans. 3-4).

¹ The Examiner's Answer includes claim 11 in the list of claims rejected on this basis. However, claim 11 was canceled in the Amendment filed February 10, 2005.

Appellants argue that “the Examiner has picked and chosen from the structures of *Ball’s instrument and its bone plate* in an attempt to identify all of the elements” (App. Br. 3). In addition, Appellants argue that the claim term “instrument” is “a term of art . . . [that] is clearly distinct from the patch-work structure of the instrument and implant identified by the Examiner. No one skilled in the art would believe that the term ‘instrument’ includes the implant.” (*Id.* at 4.) In particular, Appellants argue:

Neither the specification of the present application, nor its common usage in the art, would lead one skilled in the art to believe that an “instrument” means the combination of Ball’s instrument and implant. In short, one skilled in the art would readily understand that an instrument is used to implant a bone plate, but is not the bone plate itself.

(*Id.* at 5.)

Appellants also argue that identifying “the projecting stud 18 of [B]all’s instrument (i.e., introducer 13) . . . [as] the ‘plate attachment mechanism’ of the instrument of claim 1 . . . creates a quandary which the Examiner has not addressed” (*id.* at 4). Namely, Appellants argue:

[I]t is unclear how Ball’s stud 18 can be properly considered a “plate attachment mechanism configured to secure a bone plate to at least one of the shaft and the housing” when, according to the Examiner, the structure to which it attaches isn’t a “plate” at all, but rather under his analysis is a part of the instrument itself. In other words, the Examiner cannot have it both ways - he cannot interpret Ball’s implant 1 as part of the “instrument” for purposes of identifying structure relating to the claimed “shaft” or “tissue expander”, but then turn around and interpret the very same structure as a “bone plate” for purposes of identifying a structure associated with the claimed “plate attachment mechanism”.

(*Id.*)

ISSUES

The issues are whether Ball's implant can be considered part of the claimed "instrument" and whether Ball's projecting stud 18 can be considered the "plate attachment mechanism" of claim 1.

FINDINGS OF FACT

1. Claims 1 and 12 are each directed to a "bone plating instrument."
2. In Stedman's Medical Dictionary, the term "instrument" is defined as a "tool or implement" (27th ed. 2000; definition attached).
3. Ball discloses "an osteotomy implant **1** ha[ving] a head **2** for insertion into the upper part of the femur **3** and a shank **4** for attachment to the shaft of the femur **5**" (Ball, col. 2, ll. 57-60).
4. The Examiner identifies the head of Ball's implant as the shaft of claim 1 and as including the tissue expander of claim 12 (Ans. 4).
5. Ball discloses that the neck of the implant "has a hole **12** to receive an introducer **13**," that the "introducer **13** has a projecting stud **18** at one of its ends for insertion into the hole **12**," and that the "stud **18** also serves to carry a jig **19**" (Ball, col. 2, l. 68, to col. 3, l. 3).
6. The Examiner identifies the projecting stud 18 of Ball's introducer as the plate attachment mechanism of claim 1 (Ans. 4).

ANALYSIS

"It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification." *In re Sneed*, 710 F.2d 1544, 1548 (Fed. Cir. 1983). In Stedman's Medical Dictionary, the term "instrument" is defined as a "tool

or implement” (Finding of Fact (FF) 2). Appellants have not pointed to a definition in the Specification, or provided any other evidence, indicating that the term “instrument” should be interpreted more narrowly than this definition. Therefore, giving the term “instrument” its broadest reasonable interpretation, we agree with the Examiner that the “bone plating instrument” can include the bone plate being applied by the instrument.

Claim 1, however, recites that the “instrument” comprises “a plate attachment mechanism configured to secure a bone plate to at least one of the shaft and the housing.” The Examiner identifies the projecting stud 18 of Ball’s introducer 13 as the plate attachment mechanism (FF 6). Ball discloses that the implant receives the introducer by inserting projecting stud 18 into a hole in the implant (FF 5). When the projecting stud 18 is in this hole, such that the parts together can be considered an “instrument,” we agree with Appellants that the Examiner has not set forth a *prima facie* case that the projecting stud 18 is “configured to secure a bone plate to at least one of the shaft and the housing.” Therefore, we reverse the rejection of claim 1 and of claims 2, 3, and 5, which depend from claim 1.

Claim 12 does not recite “a plate attachment mechanism.” In addition, as discussed above, we do not agree that Ball’s implant cannot be considered part of the instrument of claim 12. We also do not agree that considering Ball’s introducer and implant, as well as Ball’s jig, as together forming the “instrument” involves any picking and choosing because Ball specifically discloses that the projecting stud of the introducer is inserted into a hole in the implant and serves to carry the jig (FF 5).

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For the above reasons, we do not agree that Appellants have overcome the Examiner's prima facie case that claim 12 is anticipated by Ball. We therefore affirm the rejection of claim 12 under 35 U.S.C. § 102(b). Claims 13 and 14 have not been argued separately and therefore fall with claim 12. 37 C.F.R. § 41.37(c)(1)(vii).

CONCLUSION

We affirm anticipation rejection of claims 12-14. However, we reverse the anticipation rejection of claims 1-3 and 5.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

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